

9200/1636

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: MAIL STOP PETITION, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, ON THE DATE INDICATED BELOW.

BY: Parrella Wright

DATE: July 29, 2003

MAIL STOP PETITION



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re:	Patent Application of Gerd Gellissen, et al.	: Group Art Unit: 1636
Appln. No.:	10/042,059	: Examiner: David A. Lambertson
Filed:	February 24, 2000	: Attorney Docket No. 29474-5007
For:	NUCLEIC ACID MOLECULE, COMPRISING A NUCLEIC ACID CODING FOR A POLYPEPTIDE WITH CHORISMATE MUTASE ACTIVITY	:

**RECEIVED**

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TECH CENTER 1600/2900

**PETITION TO WITHDRAW  
HOLDING OF ABANDONMENT  
PURSUANT TO 37 C.F.R. §1.181  
OFFICE ACTION NOT RECEIVED**

This Petition is hereby made to the Commissioner to withdraw the holding of abandonment of the above-captioned application. A Notice of Abandonment dated July 3, 2003, was received on July 7, 2003, stating that the application was abandoned for failure to respond to an office action mailed on November 6, 2002. Applicants respectfully submit that the office action was never received by Applicants' undersigned representative ("Petitioner"), and that the holding of abandonment should therefore be withdrawn under 37 C.F.R. §1.181, and pursuant to MPEP §711.03(c), based on failure to receive the office action. This Petition is being timely filed.

Petitioner hereby declares that:

1. On February 15, 2002, Petitioner filed an Information Disclosure Statement and Sequence Listing.
2. On February 25, 2002, a filing receipt and Notice to File Missing Parts dated February 19, 2002 were received by Petitioner from the PTO.
3. On March 25, 2002, Petitioner filed a response to the Notice to File Missing Parts and recorded

an assignment.

4. On July 8, 2002, a Restriction Requirement dated July 1, 2002 was received by Petitioner from the PTO.
5. On August 1, 2002, Petitioner filed a response to the Restriction Requirement.
6. On September 10, 2002, Petitioner filed an amendment.
7. On January 22, 2003, a Notice of Publication of Application mailed December 26, 2002, from the PTO was received by Petitioner .
8. A thorough search of the file jacket demonstrated that with the exception of the above-referenced documents and the corresponding return receipt postcards which are stamped to indicate that documents were received by the PTO, the Notice of Publication of Application is the last correspondence, originating from the PTO, which was received by Petitioner regarding the above-referenced application prior to receipt of the Notice of Abandonment dated July 3, 2003.
9. On or about mid-June, 2003, Petitioner's representative, Raquel M. Alvarez, Esquire, contacted Examiner Lambertson to ascertain the status of the application. Examiner Lambertson informed Dr. Alvarez that the application would go abandoned for failure to respond to an office action.
10. Upon receipt of this information, and prior to receiving the official Notice of Abandonment on July 7, 2003, Petitioner reviewed a log of all incoming mail from the PTO for the pertinent period, *i.e.*, from November 8, 2002, through November 13, 2002, to definitively determine whether the Restriction Requirement had been received by Petitioners. That is, Petitioner's law firm, Morgan, Lewis & Bockius, LLP ("MLB"), maintains an "Incoming PTO Log," wherein all correspondence received from the PTO is routinely recorded. During the time period in question, an entry was made in the Incoming PTO Log for each piece of correspondence indicating the application number on the correspondence, the nature of the correspondence, the client matter number (attorney docket number), and the name or initials of the person to which the correspondence was routed. Docketing information was then recorded in MLB's automated docketing system for a response, including any response deadline(s) pertaining to each piece of correspondence, for the attention of the responsible attorney. If a document does not appear on the Incoming PTO Log, there is no possibility that it was received or docketed by Petitioners.
11. A copy of the MLB Incoming PTO Log for the period from November 8, 2002, through November 13, 2002, is attached as Exhibit A. This log demonstrates that Petitioner did not receive the office action in question because the Office Action would have been entered on the Incoming PTO Log had it been received and no such entry appears on the log.

12. Also attached is a copy of Petitioner's application computer docket report for the period of September 27, 2001, to present, for the above-captioned application, which is marked as Exhibit B. The attached printout reflects all docketed matters for the application (Ser. No. 10/042,059), including during the period in question. The application computer docket report entries for the application (referenced by case number 29474-5007) demonstrate that the Office Action was not received by Petitioner. This is because if an Office Action had been received, it would have been duly docketed in Petitioner's computer docketing system, which would have also provided a response period for the office action. That is, if the nonreceived action had been received, a record of the Office Action, and the deadline for a response thereto, would have appeared on this computer docket report. The fact that no such entry appears on the computer docket report further demonstrates that Petitioner never received the Office Action apparently sent by the PTO on November 6, 2002.
13. In addition, a search of the application file jacket was made and did not result in the paper in question being found. Based upon Petitioner's file jacket search, review of the PTO Incoming Log, and review of the computer docketing record, Petitioner believes and asserts that the Office Action mailed on November 6, 2002, was never received.
14. In sum, Petitioner's review of the pages of Petitioner's MLB Incoming PTO Log for the period from November 8, 2002, through November 13, 2002, shows no indication of the receipt of an Office Action in the above-referenced application. Further, Petitioner's review of the computer docketing entries made during that same time period reveals no docketing entries corresponding to a response deadline for any Office Action for this application. If the Office Action had been received, it would have been indicated on these records. Additionally, a search of the file jacket demonstrated that the Office Action was not received by Petitioner. Thus, Petitioner respectfully submits that the Office Action was either never mailed or it was lost in the mail and that the facts averred herein amply support that the Office Action was not received by Petitioner and that the holding of abandonment should be withdrawn for failure to receive the office action.

Accordingly, it is respectfully requested that the holding of abandonment of this application be withdrawn and the above-captioned application (No. 10/042,059) be reinstated. Further, Petitioner respectfully requests that the Office Action be remailed to Petitioner and that a new statutory period for response be set therefor.

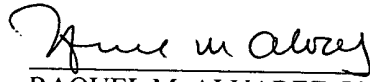
Petitioner believes that there is no fee required with respect to this Petition. However, in the event any fee is necessary, please charge such fee to Deposit Account No. 50-0310 (Internal Billing No. 29474-5007).

Respectfully submitted,

**GERD GELLISSEN, ET AL.**

July 29, 2003  
(Date)

By:

  
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/dp

Enclosures:

Exhibit A – Copy of MLB's Incoming PTO Log from November 8, 2002, through November 13, 2002  
Exhibit B – Copy of Application Computer Docket Report from September 27, 2001, to present  
Copy of Notice of Abandonment, dated July 3, 2003



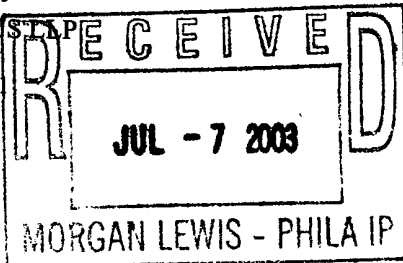
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,059	10/25/2001	Gerd Gellissen	029474-5007	5408

28977 7590 07/03/2003

MORGAN, LEWIS & BOCKIUS  
1701 MARKET STREET  
PHILADELPHIA, PA 19103-292



EXAMINER

LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

18

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.


Docketed 9/7/03 Attorney RMA  
Case 29474-5007  
Due Date 9-3-03  
Action Deletion to Withdrawal Abandonment.  
By JFC Chk ALL

<b>Notice of Abandonment</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/042,059	GELLISSEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David A. Lambertson	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 06 November 2002.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

  
 DAVID GUZO  
 PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

**Examiner-Initiated Interview Summary**

Application No.

10/042,059

Applicant(s)

GELLISSEN ET AL.

Examiner

David A. Lambertson

Art Unit

1636

**All Participants:**(1) David A. Lambertson.(2) Raquel Alvarez.**Status of Application:** Abandoned

(3) \_\_\_\_\_.

(4) \_\_\_\_\_.

**Date of Interview:** 2 July 2003**Time:** 2 pm**Type of Interview:**

- ☒ Telephonic  
☐ Video Conference  
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☒ No

If Yes, provide a brief description:

**Part I.**

Rejection(s) discussed:

Claims discussed:

Prior art documents discussed:

**Part II.****SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:**

*Applicant's attorney/agent was contacted regarding the status of the case. The examiner indicated that the case was abandoned, and that applicant would need to petition in order to get the case revived.*

**Part III.**

- ☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
- ☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature – if appropriate)